

REMARKS

The Examiner is thanked for the thorough examination of this application. The Office Action, however, has tentatively rejected all claims. On a substantive basis, the Office Action has alleged that the claims are obvious over the combination of U.S. Patent 6,404,875 to Malik (hereafter Malik) and U.S. Patent 6,542,942 to Gulati (hereafter Gulati). For at least the reasons set forth below, Applicant respectfully disagrees and requests reconsideration and withdrawal of the rejections.

Claim Objection

As an initial matter, the Office Action objected to claim 1, due to a typographical informality therein. Applicant has amended claim 1 according to the Examiner's suggestion, and Applicant submits this objection should now be withdrawn.

Discussion of Rejections

Fundamental Distinction of All Claims Over Cited References

Turning now to the substance of the Office Action, the Office Action has rejected all claims as allegedly obvious over the combination of Malik and Gulati. Applicant respectfully disagrees. As is clear from the originally-filed claims (when properly construed), the Applicant's claimed invention is directed to a system and method for accessing software components in a distributed computer network environment. In stark contrast, the cited references relate to telecommunication systems. Simply stated, the two distinct environments are vastly different, particularly in the context of the presently-claimed invention. Nevertheless, Applicant has amended each of the independent claims to clarify that the environment of the claimed invention is "distributed computer networked systems." This

alone is sufficient to distinguish the presently-claimed invention over the applied art. In addition, each of the claims of the present application define a system or method for "accessing a software component" over such a networked system. Neither of the cited references teaches, discloses, or suggests such a system.

Paragraph 8 of the Office Action, alleges that "Malik has taught ... a method for accessing a remote software component comprising:..." The Office Action, however, has failed to cite any location in Malik for this alleged teaching. In fact, the very first sentence of the abstract of Malik (providing a broad characterization of that system) characterizes that invention as disclosing "a telecommunications system initiating telephone connections between, for example a consumer and a service provider based on the criteria provided by the consumer and the services available from the service provider." Simply stated, the initiation of a telephone call over a telecommunications system is vastly different than a system or method (in a distributed computer network system) for accessing remote software components. For at least this reason, the cited prior art has been misapplied to the claimed invention and the rejections should be withdrawn.

Anticipating that the Patent Office may take the position (as it sometimes does) that this claimed feature is embodied in the preambles of the claims, and is therefore not limiting on the claims, Applicant notes that well-established precedent from the Federal Circuit provides otherwise. In this regard, the Federal Circuit has clarified that proper claim construction also includes construing the language in a preamble, particularly when the preamble defines an environment of the invention, that is "necessary to give life, meaning and vitality" to the claim. See *In re Stencel*, 828 F.2d 751, 754, (Fed. Cir. 1987); .*" Bell Communications Research, Inc. v. Vitalink Communications Corp.*, 55 F.3d 615, 620 (Fed.

Cir. 1995); *Applied Materials, Inc. v. Advanced Semiconductor Materials Am., Inc.*, 98 F.3d 1563, 1572-73, (Fed. Cir. 1996).

Further, the Office Action has relied upon Malik for allegedly providing the principal teachings of the claimed features. The inapplicability of Malik (noted above) is underscored by the Office Action's admission that "Malik as not explicitly taught broadcasting the request." In fact, Malik discloses (see FIG. 1a) a telecommunication network comprising a PSTN (plain old telephone network), communicating with an SSP (service switching point), STP (signaling transfer point) and SCP (service control point). In such a telephone system "broadcast" messages are not possible. The consumer (at a telephone on the PSTN) is connected to the service provider via a point-to-point connection (over a two-wire pair, known as the local loop). In such an environment, a consumer simply cannot broadcast a message to multiple service providers.

Therefore, the Office Action's statement that "Malik has not explicitly taught broadcasting the request" is a drastic understatement, as such a teaching could not even remotely be thought to be implicitly taught either. This underscores the significant misapplication of Malik to the presently claimed invention. For at least this reason, the rejections (as to all claims are misplaced, and should be withdrawn).

Notwithstanding the foregoing global distinction that is applicable to all claims, each independent claim will be individually discussed below.

New Claim 21

Applicant has added new claim 21 herein, which clearly defines over the cited art. In this regard, new claim 21 generally parallels claim 1, but specifies that the broadcast request is received by a *plurality* of service provides, *each of which responds* to the broadcast

message. In the telecommunication system of Malik such is not possible, as there is only one service provider. In fact, Malik specifically states that "During Information Collection function 18, a caller dials the telephone number assigned to the system of the present invention using telephone 6 ..." As such, and as is well known, a point-to-point communication channel is established between the consumer and service provider. Over such a connection, a "broadcast" (e.g., point-to-multipoint) of a request cannot be made. Further, in Malik, only one service provider (not a plurality of service providers, as claimed) receives the communication from the consumer. Likewise, new claim 21 calls for each of the plurality of service providers to respond to the consumer, and there is no such disclosure or suggestion in the cited art. For at least these reasons, claim 21 patently defines over the cited art of record.

Claims 1-11

Turning now to the rejected claims, the Office Action rejected independent claim 1 as allegedly obvious over the combination of Gulati and Malik. For at least the reasons set forth below, Applicant respectfully disagrees.

Independent claim 1 recites:

1. In a *distributed computer networked system* having at least one service consumer and at least one service provider, a *method for accessing a remote software component by a service consumer* comprising:
 generating a request for a component having at least one specified attribute;
 broadcasting the request across the network;
 receiving the request at a service provider;
 comparing at least one specified attribute of the received request with component attributes of the service provider; and
 communicating a response to the requesting service consumer.

(*Emphasis added.*) Claim 1 patently defines over the cited art for at least the reason that the cited art fails to disclose the features emphasized above.

With regard to the “distributed computer networked system” and “method for accessing a remote software component” features, these features were discussed above in connection with the fundamental distinction. That discussion is repeated and realleged herein, and for at least the reason that the cited art does not disclose these features, the rejection of claim 1 is misplaced and should be withdrawn.

As a separate and independent basis for the patentability of claim 1, claim 1 recites *“generating a request for a component having at least one specified attribute”* and *“broadcasting the request across the network.”* The Office Action alleges that the first feature is taught by Malik (citing – in part – “figure 1b step 18”). Applicant respectfully disagrees. Step 18 of figure 1b clearly does not teach or suggest this step. In fact, Malik specifically states: “During Information Collection function 18, a caller dials the telephone number assigned to the system of the present invention using telephone 6 connected to the Service Switching Point (“SSP”) 1.” Therefore, Malik does not disclose or suggest the generating of a request for a component having at least one specified attribute, as defined by claim 1. For at least this additional reason, independent claim 1 defines over the cited art.

As to the second feature, the Office Action alleges that Malik discloses the transmission of “the request across the network (figure 1a, request is sent for determination) (see Office Action paragraph 8(b)). In fact, Malik only teaches the communication between the consumer and service provider (across a point-to-point link). Applicant respectfully submits that the application of Malik to this claimed feature is misplaced and separately warrants removal of the rejection.

For at least the foregoing reasons, the rejection of claim 1 should be withdrawn. For at least the same reasons the rejections of claims 2-11, which depend from claim 1, should be withdrawn as well.

Claims 12-19

The Office Action rejected independent claim 12 as allegedly obvious over the combination of Gulati and Malik, for the same reason as claim 1 (Office Action, paragraph 19). Therefore, Applicant submits that the rejection of claim 12 should be withdrawn for at least the same reasons as claim 1.

With regard to dependent claims 12-19, the rejections to those claims should be withdrawn insofar as they depend from claim 12, and the rejection of claim 12 should be withdrawn.

Claim 20

The Office Action rejected independent claim 20 as allegedly obvious over the combination of Gulati and Malik, for the same reason as claim 1 (Office Action, paragraph 22). Therefore, Applicant submits that the rejection of claim 20 should be withdrawn for at least the same reasons as claim 1.

Combination of Gulati with Malik is Improper

As a separate and independent basis for the patentability of all claims, Applicant respectfully submits that the combination of Gulati with Malik is improper and should be withdrawn.

The Office Action rejected all claims 1-20 as allegedly obvious over the combination of Malik and Gulati. In forming this rejection, the Office Action merely concluded that the combination of these two references would have been obvious “because the broadcasting method would facilitate the exchange of information, and multiple devices operatively

connected to the network as taught by Gulati (Col 2 lines 18-21).” (Office Action, page 8, third paragraph). Applicant respectfully disagrees. Among other reasons for traversing this rejection, Applicant respectfully submits that this rejection falls far short of the legal requirements for forming rejections under 35 U.S.C. § 103(a).

In this regard, it is well-settled law that in order to properly support an obviousness rejection under 35 U.S.C. § 103, there must have been some teaching in the prior art to suggest to one skilled in the art that the claimed invention would have been obvious. W. L. Gore & Associates, Inc. v. Garlock Thomas, Inc., 721 F.2d 1540, 1551 (Fed. Cir. 1983). More significantly,

"The consistent criteria for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this [invention] should be carried out and would have a reasonable likelihood of success, viewed in light of the prior art. ..." Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure... In determining whether such a suggestion can fairly be gleaned from the prior art, the full field of the invention must be considered; for the person of ordinary skill in the art is charged with knowledge of the entire body of technological literature, including that which might lead away from the claimed invention."

(Emphasis added) In re Dow Chemical Company, 837 F.2d 469, 473 (Fed. Cir. 1988).

In this regard, Applicant notes that there must not only be a suggestion to combine the functional or operational aspects of the combined references, but that the Federal Circuit also requires the prior art to suggest both the combination of elements and the structure resulting from the combination. Stiftung v. Renishaw PLC, 945 Fed.2d 1173 (Fed. Cir. 1991). Therefore, in order to sustain an obviousness rejection based upon a combination of any two or more prior art references, the prior art must properly suggest the desirability of combining the particular elements to create a system or method for accessing a remote software component by a service consumer over a distributed computer networked system, as defined by the pending claims.

When an obviousness determination is based on multiple prior art references, there must be a showing of some “teaching, suggestion, or reason” to combine the references.

Gambro Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573, 1579, 42 USPQ2d 1378, 1383 (Fed. Cir. 1997) (also noting that the “absence of such a suggestion to combine is dispositive in an obviousness determination”).

Evidence of a suggestion, teaching, or motivation to combine prior art references may flow, inter alia, from the references themselves, the knowledge of one of ordinary skill in the art, or from the nature of the problem to be solved. See In re Dembiczak, 175 F.3d 994, 1000, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Although a reference need not expressly teach that the disclosure contained therein should be combined with another, the showing of combinability, in whatever form, must nevertheless be “clear and particular.” Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617.

If there was no motivation or suggestion to combine selective teachings from multiple prior art references, one of ordinary skill in the art would not have viewed the present invention as obvious. See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); Gambro Lundia AB, 110 F.3d at 1579, 42 USPQ2d at 1383 (“The absence of such a suggestion to combine is dispositive in an obviousness determination.”).

Significantly, where there is no apparent disadvantage present in a particular prior art reference, then generally there can be no motivation to combine the teaching of another reference with the particular prior art reference. Winner Int'l Royalty Corp. v. Wang, No 98-1553 (Fed. Cir. January 27, 2000). The Office Action has failed to cite any apparent disadvantage of Malik, which would prompt the combination of select teachings of Gulati therewith.

For at least this separate and independent basis, the rejections of claims 1-20 should be withdrawn.

As a further reason for traversing the combination of Gulati with Malik, Applicant respectfully submits that the combination proposed by the Office Action is inoperative. As mentioned above Malik teaches a connection between a consumer and service provider via the PSTN, which is a point to point connection. A the broadcast feature of Gulati simply cannot be implemented in such an embodiment. That is, a consumer cannot broadcast a message over the PSTN to a plurality of service providers, but rather establishes a connection with only a single service provider.

For at least these additional reasons, Applicant submits that the combination of Gulati with Malik is improper, and therefore the rejection of claims 1-20 should be with drawn.

CONCLUSION

In view of the foregoing, it is believed that all pending claims are in proper condition for allowance. If the Examiner believes that a telephone conference would expedite the examination of the above-identified patent application, the Examiner is invited to call the undersigned.

No fee is believed to be due in connection with this amendment and response to Office Action. If, however, any fee is believed to be due, you are hereby authorized to charge any such fee to Hewlett-Packard Company's deposit account No. 08-2025.

Respectfully submitted,

By:



Daniel R. McClure
Registration No. 38,962

Thomas, Kayden, Horstemeyer & Risley, LLP
100 Galleria Pkwy, NW
Suite 1750
Atlanta, GA 30339
770-933-9500

Please continue to send all future correspondence to:

Hewlett-Packard Development Company, L.P.
Intellectual Property Administration
P.O. Box 272400
Fort Collins, Colorado 80527-2400